



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,676	10/10/2001	Toshihiro Morita	275782US6	7507
22850	7590	01/20/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			AMSBURY, WAYNE P	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/974,676		MORITA ET AL.	
	Examiner		Art Unit	
	Wayne Amsbury		2161	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/4/2.10/21/5, 1/1/02</u> | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 1-17 ARE PENDING

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 15 recite the limitation "the third format" in line 4. There is insufficient antecedent basis for this limitation in the claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi, US 6,738,562, 18 May 2004.

Art Unit: 2161

Takeuchi is directed to optical disc playback that displays an on-screen display message (OSD) [COL 1 lines 6-12] for either image or sounds, or both [COL 1 lines 14-28].

As to **claim 1**:

An information processing apparatus comprising:

record controlling means for controlling a record in which first data identifying a content, a second data identifying a first file for storing the content in a first format, and a third data identifying a second file for storing the content in a second format are correlated;

specifying means for specifying the content on the basis of the first data;

Takeuchi reads record data from an optical disc [COL 5 lines 3-11], wherein an OSD can be formatted depending upon data in the disc [COL 5 lines 12-14]. The disc data determines the format of video on the disc is CD-DA for music, or PAL or NTSC for video [COL 1 lines 65-66; COL 2 lines 16-19]. The disc contains content data (first data), the format data (first and second data) is also on the disc, and these determine the display format of the OSD [COL 5 lines 12-14; FIG 4].

Takeuchi does not explicitly state that the displays, in their appropriate format, are stored as files. They do however pass through the buffer memory 17 [FIG 1-12].

It would have been obvious to one of ordinary skill in the art at the time of the invention to store the formatted data as files because that would make them efficiently addressable data blocks.

selecting means for selecting either the first file or the second file in association with the specified content; and

The selecting means is a format determination unit [COL 5 lines 26-34].

manipulating means for manipulating the first file or the second file on the basis of the second data or the third data in association with either the first file or the second file, whichever has been selected.

An on-screen display controller 7A [FIG 10-12; COL 2 lines 29-32] manipulates the display files according to their content.

As to **claims 2-4**, the system of Takeuchi is directed to reproduction of the disc content – playback [COL 1 lines 6-12]; there is a single manipulating means in both claim and Takeuchi that in the latter case contains an inherent switch between the display means as either 10 or 12 lines; and there is a transfer to the display screen.

As to **claim 5**, the choice of display format corresponds to a setting.

As to **claim 6**, the content of the first disc determines the content of the display in accordance with the format [FIG 4,12].

As to **claim 7**, Takeuchi notes a number of formats, MPEG1, MPEG2 [COL 1 lines 13-28], CD-DA [COL 61-66], PAL and NTSC [COL 2 lines 21-29]. IT is clear in the discussion that a number of formats are in use and change often. Thus **it would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for any number of formats as needed because of the increased utility of this provision.


As to **claim 8**, the use of a buffer [77], as noted above implies that the OSD files are temporary and thus deleted as needed.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA


WAYNE AMSBURY
PRIMARY PATENT EXAMINER